

REMARKS

Claims 29 to 33 are added, and therefore claims 14 to 33 are pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 14 to 26 were rejected under 35 U.S.C. § 103(a) as obvious over German Patent No. DE 10153484 (the “Gilge” reference) in view of Local Area Networks Architectures and Implementations (the “Martin” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 14, as presented, is to *an evaluation device configured to analyze output of at least a subset of the signal processors, the evaluation device and the at least a subset of the signal processors each forming a direct link to one of a central hub, a switch and a port, of a network having a star-shaped topology*. As presented, claim 14 provides that the evaluation

device and the at least a subset of processors are each directly linked to a central hub/switch/port in a star network.

The Final Office Action conclusorily asserts the rationale of applying a known technique to a known device ready for improvement to yield predictable results. To rely on this rationale, the Office must articulate the following: (1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement”; (2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product); (3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. M.P.E.P. § 2143. As explained below, the present rejections do not articulate the foregoing.

In particular, claim 14 provides for additional structural features as to the recited star-shaped network. For example, the evaluation device and the at least a subset of processors are each directly linked to a central hub/switch/port to form the star network. This feature is conspicuously absent in the “Gilge” reference and therefore the system 40 does not constitute an analogous star-shaped network—even if it correspond to a star-shaped network at all. Based upon the conclusory assertion that the system 40 constitutes a star-shaped network, the Final Office Action ascribes networking features to the system 40—features which are nowhere to be found in the “Gilge” reference (including, for example, the features of evaluating data, balancing network traffic, recording network data, performing network error checking and correction, and adapting to increased workload from additional devices).

To the extent that the Final Office Action may be relying on the inherency doctrine with reference to the above mentioned networking features, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Elsewhere, the Final Office Action further attempts to analogize the system 40 to a network. (Final Office Action, ¶¶ 13 to 16). For example, the Final Office Action asserts that the system 40 is used with LANs, WANs and other networks. (Final Office Action, ¶ 13). However, the “Gilge” reference merely refers to the evaluation device 72 as being coupled to a network, i.e., the digital network 36, whereas the rest of the system 40 (including the evaluation device 72) is not described as a network and therefore does not have the above mentioned networking features.

The Final Office Action also asserts that there is an alleged need for the above mentioned networking features. (Final Office Action, ¶ 14). In view of the complete lack of disclosure that these features would even be applicable to the system 40, and also based on the reasons explained above as to why the system 40 does not include these features, it is respectfully submitted that one skilled in the art would not recognize such a need -- as evidenced by the cited references failure to recognize the need as asserted by the Office.

The above mentioned networking features are relied on as the basis for the asserted “predictable results” of combining the “Gilge” reference with the “Martin” reference. Because these features are neither disclosed nor suggested in the “Gilge” reference, the Final Office Action’s conclusory assertion of predictable results cannot be and is not properly supported.

Also, the “Martin” reference does not teach a “known technique” that is applicable to the alleged “base” device of the “Gilge” reference. In this regard, the system of the present application cannot be arrived at simply by substituting a hub/switch for the evaluation device 72. In the “Gilge” reference, the processing means 46, 48, the digital network 36 and the storage device 74 are specifically configured to communicate only with the evaluation device 72. Therefore, it is unclear at best whether a mere substitution of elements would suffice to maintain the functionality of the system 40. Moreover, substitution fails to account for why the evaluation device would form a direct link to the hub/switch after having been replaced.

Based on these reasons, it is respectfully submitted that the “Martin” reference does not cure the deficiencies of the primary “Gilge” reference, so that one skilled in the art would not be motivated to combine these references.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by

the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

For at least the above reasons, claim 14, as presented, is allowable, as are its dependent claims 15 to 28.

New claims 29 to 33 do not add any new matter and are supported by the present application. Claims 29 to 33 depend from claim 14, and they are therefore allowable for the same reasons as claim 14. Additionally, each of claims 29 to 33 provides further features that are not disclosed or suggested by the applied references, as any review of the applied references makes plain.

In sum, claims 14 to 33 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of presently pending claims 14 to 33 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

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